

REMARKS

Applicants note with appreciation the thorough examination provided in the above-referenced application. By way of this amendment which is submitted to be fully responsive to the outstanding Office Action of Paper No. 20060307, claims 1, 4, and 5 have been amended, while claims 20-23 have been canceled. Claim 1 has been amended consistent with Figs. 3 and 4 and the corresponding specification text to state with greater clarity that the inventive key cover is not affixed to a conventional key inserted therein, and rather only through the simultaneous contact between an inventive key cover and a conventional key by a key ring is the alignment between the opening and a conventional key head with the apertures of an inventive key cover maintained.

The law is well established that such language need not be described literally or "*in haec verba*" in order for the specification to satisfy the written description requirement for claimed subject matter. As stated by the court in *Staehelin v. Secher*, 24 USPQ2d 1513, 1519 (BPAI 1992), "the question, therefore is whether the originally filed application would have reasonably conveyed to a person of ordinary skill in the art that the applicants invented the subject matter later claimed by them including the limitations in question."

Support for the amendments to claim 5 are found in the middle key depicted in Fig. 4 as originally filed, as well as claims 1 and 2 which are incorporated into claim 5. Amendments to claim 4 are typographical in nature to provide proper antecedent basis for the term "geometric shape." As such, it is submitted that no new matter has been added to the application by way of these amendments.

Currently, claims 4 and 5 stand objected to with regard to omission of the word “the” preceding “wherein” in an inadvertent omission of dependency in claims 4 and 5, respectively. The amendments made to claims 4 and 5 are believed to have been corrected, and, as such, the objections to claims 4 and 5 are believed to no longer be proper.

Claims 1-4, 6, 8, 9, and 12-19 currently stand rejected under 35 U.S.C. §103(a) over DM/059931 in view of Cicourel and either Rafter or Bianchi, all prior art references of record. Claim 5 also stands rejected under 35 U.S.C. §103(a) as applied to claim 2 in view of additional teachings of the DM reference or Lesko. Claim 7 also stands rejected under 35 U.S.C. §103(a) as applied to claim 6 and further in view of additional teachings of the DM reference. Lastly, claim 11 stands rejected under 35 U.S.C. §103(a) as applied to claim 1 and further in view of Sheldon.

**Remarks Directed to Rejection of Claims 1-4, 6, 8, 9, and 12-19 Under
35 U.S.C. §103(a) over DM/059931 in View of Cicourel and Either Rafter or Bianchi**

The basis of this rejection is that the DM reference with reference to FIGS. 6.2, 6.3, 2.2, and 2.3 teaches the majority of the elements of the pending claims Cicourel is cited to cure the deficiency of the DM reference with regard to the tactile features being secured throughout the rear contact plane with the plane of the sidewall on which they are secured as well as the tactile features being formed of a common material with the inventive key head cover. Rafter is cited with respect to reference 12 in Figure 5 as teaching of a house icon which may be formed of metal as set forth in column 6, line 27. Bianchi is cited for the teaching of a thermoplastic key cover material with reference to 30 (column 2, line 31-column 3, line 1). (Paper No. 20060307 paragraph spanning pages 2-3) The basis of the rejection is that “it would have been obvious to form the tactile features of the DM reference as being secured throughout their rear contact plane to the plane of the sidewalls, and as a single material with the sidewalls, in view of the teaching of

Cicourel, the motivation being to optimize the strength of the connection between the tactile features in the sidewall, as well as to simplify the assembly of the key head cover. It would have been obvious to form the key head cover of the DM references modified by Cicourel, to be formed from metal or thermoplastic in view of the respective teachings of Rafter or Bianchi . . .” (Paper No. 20060307, page 3, paragraph continuing from page 2).

Claim 1 in amended form recites the necessity of a key ring to retain a conventional key and an inventive key cover in the recited alignment between the key opening and the aligned apertures of the inventive key cover.

Applicants submit that secondary the references of Cicourel, Rafter, and Bianchi each in turn teach away from the prior art reference combination of the instant rejection. It is well-established case law that “a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered.” *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Cicourel teaches at lines 28-32 that the key cover is “snugly fit” to the handle part of the key and formed of rubber so that it is stretched over the handle part of the key as the handle portion of the key is pressed through the opening in the key cover. It is already made of record that the key cover of Cicourel is elastomeric and retained on the key head independent of a key ring with this key ring being in a state of stretched tension while encompassing the key head. Likewise, the key head cover of Rafter retains casing 12 in contact with a key plane 28 through resort to press tabs (66c in Fig. 5, column 6, lines 32-37) to retain a casing 12 in a relative position relative to the key. Lastly, Bianchi teaches a covering (reference numeral 30 with respect to the Figures) in column 2, lines 35-42 that is molded around the key head. Each of these secondary

references of Cicourel, Rafter, and Bianchi is purposeful and explicit that the forms of key coverings taught must be provided in a form in which the key cover is secured directly to the key.

Specifically, Cicourel is adamant that tension of the key cover requires an elastic property to the key cover. This is an integral part of the teaching of Cicourel. As such, Cicourel strongly disfavors the prior art reference combination of record. Additionally, Rafter, and Bianchi while teaching key cover components being formed of metal and thermoplastic respectively, also teach a key cover retained to a key by a fastening system originally securing the key cover to the key. Cicourel, in providing an elastomeric snug fit, represents another fastening between the key cover in the surrounded key.

As a result, it is submitted that one of skill in the art, upon considering the combination of the DM reference being modified by Cicourel and forming the modified piece from metal per Rafter or thermoplastic per Bianchi, would produce a key cover that secures itself to the key. In contrast to the invention produced by the prior art reference combination, pending claim 1 recites a key cover being secured to a key only through the key ring passing through both the key cover and the encompassed key. As the prior art reference combination fails to afford the claimed invention and further that the teachings of Cicourel, Rafter, and Bianchi teach away from the claimed invention, reconsideration of the rejection as to claim 1 and those claims that depend therefrom is respectfully requested.

With regard to additional bases for patentability of claims dependent from claim 1, Applicants thereby incorporate the remarks previously made of record.

In light of the above amendments and remarks, reconsideration and withdrawal of the rejection as to claims 1-4, 6, 8, 9, and 12-19 under 35 U.S.C. §103(a) over the DM/059931 reference in view of Cicourel and either Rafter or Bianchi is requested.

Remarks Directed to Rejection of Claim 5 Under 35 U.S.C. §103(a)

The subject matter of claim 5 includes a first geometric feature raised above the plane of the first sidewall, and a second geometric shape depressed beneath the plane of the first sidewall. The combination of a raised and depressed feature being readily communicated between a cited and blind users of a key encompassed within such a key cover. (The middle key depicted in Fig. 4 as originally filed is representative of an inventive key cover per claim 5.) The combination of a raised and depressed feature being readily communicated between a cited and blind users of a key encompassed within such a key cover.

The DM reference with respect to Figs. 9.1-9.3 only shows a depressed feature. Likewise, Lesko, with respect to the various punches and indentations shown in Figs. 1-4, only depressed features are shown. Indeed, Lesko takes pains to provide a chamber at reference 16 such that nail-points and Burrs do not extend beyond the plane of the key.

As a result, Applicants submit that the prior combination lacks recitations found within pending claim 5, these recitations being entitled to patentable weight.

In light of the above amendments and remarks, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) over the DM reference in view of Cicourel, either Rafter or Bianchi, and further in view of the DM reference or Lesko is requested.

Remarks Directed to the Rejection of Claim 11 Under 35 U.S.C. §103(a)

Sheldon is cited to bolster the reference combination serving as a basis for the allowance of claim 1 in regard to having a key ring secured to hold at least a multiple of keys having different identifiers. Sheldon submitted to also teach away from the prior art combination as detailed above with respect to claim 1 in that the spring clip 20 comprises of a folded portion 19 onto the key 11 to hold the key in place (column 2, lines 50-53). As such, the prior art reference

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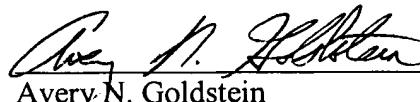
combination is again deficient in that the prior art reference combination as showed includes as a modification to the DM reference that the key be depressed in some manner in alignment with the key cover. As the pending claims specifically contravene this teaching, claim 11 is submitted to be patentably distinct based on the limitations of claim 1 incorporated within pending claim 11.

In light of the above amendments and remarks, reconsideration and withdrawal of the rejection as to claim 11 under 35 U.S.C. §103(a) over the DM reference in view of Cicourel, either Rafter or Bianchi, and further in view of Sheldon is requested.

Summary

Claims 1-9 and 12-19 remain pending in this application. Each claim is believed to be in allowable form and directed to patentable subject matter. Reconsideration and allowance of the claims is solicited. Should the Examiner have any suggestions as to how to improve the form of any of the pending claims, he is respectfully requested to contact the undersigned attorney in charge of this application.

Respectfully submitted,


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